



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,235	01/13/2000	John L. Wood	OCR-729/756	6715

7590 01/21/2005
Arthur G Schaier
Carmody & Torrance, LLP
50 Leavenworth Street, P.O. Box 1110
Waterbury, CT 06721

EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
----------	--------------

1624

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/482,235

Applicant(s)

WOOD ET AL.

Examiner

Brenda Coleman

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5,8-11,13-16,19-24,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5,8-11,13-16,19-24,26 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 3-5, 8-11, 13-16, 19-24, 26 and 27 are pending in the application.

This action is in response to applicants' amendment dated November 9, 2004.

Claim 12 has been canceled.

Response to Arguments

Applicants' arguments filed November 9, 2004 have been fully considered with the following effect:

1. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, first paragraph labeled paragraph 1 in the last office action, which is hereby **withdrawn**.
2. With regards to the 35 U.S.C. § 102 anticipation rejection of claims 3-5, 8-16, 19-24, 26 and 27 maintained in the last office action, the applicant's arguments have been fully considered but are not found persuasive. The instant claims are not described in the applicants priority document and thus are only entitled to benefit of U.S. Application No. 08/817,230 filed June 4, 1997 as it is only completely described in the U.S. Application No. 09/206,082 filed December 4, 1998. Note In re Scheiber 199 USPQ 782 regarding 112 compliance for benefit under 35 USC 120. The applicants are urging benefit of provisional application No. 60/002,164, however, since the instant application is not claiming benefit of 60/002,164 directly, they are not entitled to benefit of August 11, 1995. Provisional application No. 60/002,164 must be pending at the time of filing of non-provisional application no. 09/206,082 of which it is not. The applicants cannot ignore the fact the there are several non-provisional applications between the filing of

the provisional and the instant application where the definition for instant R is not described. The applicants are arguing that the incorporation by reference of each of the applicants priority documents is sufficient to establish continuity between each of the non-provisional applications. However, incorporation by reference can only be obtained as follows: The incorporation of essential material in the specification by reference to a foreign application, i.e. PCT/IB96/00987 or patent, or to a publication **is improper**. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973). Hence, applicants are only entitled to a filing date of December 4, 1998.

Claims 3-5, 8-11, 13-16, 19-24, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood et al., Tetrahedron Letters, for reasons of record and stated above.

3. With regards to the 35 U.S.C. § 102 anticipation rejection of claims 3-5, 8-16, 19-24, 26 and 27 maintained in the last office action, the applicant's arguments have been fully considered but are not found persuasive. The instant claims are not described in the applicants priority document and thus are only entitled to benefit of U.S. Application No. 08/817,230 filed June 4, 1997 as it is only completely described in the U.S.

Application No. 09/206,082 filed December 4, 1998. Note *In re Scheiber* 199 USPQ 782 regarding 112 compliance for benefit under 35 USC 120. The applicants are urging benefit of provisional application No. 60/002,164, however, since the instant application is not claiming benefit of 60/002,164 directly, they are not entitled to benefit of August 11, 1995. Provisional application No. 60/002,164 must be pending at the time of filing of non-provisional application no. 09/206,082 of which it is not. The applicants cannot ignore the fact the there are several non-provisional applications between the filing of the provisional and the instant application where the definition for instant R is not described. The applicants are arguing that the incorporation by reference of each of the applicants priority documents is sufficient to establish continuity between each of the non-provisional applications. However, incorporation by reference can only be obtained as follows: The incorporation of essential material in the specification by reference to a foreign application, i.e. PCT/IB96/00987 or patent, or to a publication **is improper**. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973). Hence, applicants are only entitled to a filing date of December 4, 1998.

Claims 3-5, 8-11, 13-16, 19-24, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood et al., Journal of American Chemical Society, for reasons of record and stated above.

4. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled h), maintained in the last office action, which are hereby **withdrawn**.

5. With regards to the 35 U.S.C. § 112, first paragraph rejection of claims 26 and 27 of the last office action, the applicant's arguments have been fully considered but are not found persuasive. The applicants stated that the instant application as well as each of the earlier filed applications back to the Provisional Application, specifically incorporate by reference all of the earlier filed applications. However, as stated above, incorporation by reference can only be obtained as follows: The incorporation of essential material in the specification by reference to a foreign application, i.e. PCT/IB96/00987 or patent, or to a publication **is improper**. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Claims 26 and 27 and claims dependent thereon are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for reasons of record and stated above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Brenda Coleman". The signature is fluid and cursive, with a long, sweeping underline that extends to the right.

Brenda Coleman
Primary Examiner Art Unit 1624
January 19, 2005